

09/990,597

467XXBX

REMARKS

Claims 1-105 are currently pending in the subject application and are presently under consideration. Applicants' representative acknowledges with appreciation allowance of claims 33-51, 57-74, 80-98, and the indication of claims 99-105 as being allowable subject to correction of a phrase therein. Applicants' representative submits that such correction is not necessary as described in detail *infra*.

Favorable reconsideration of the application is requested in view of the comments below.

I. Objection of Claim 99

Claim 99 is objected to because of the phrase "the improvement comprising". It is respectfully submitted that such phrase is a transitional phrase for a combination claim, and complies with USPTO practices as explained in 37 C.F.R. 1.75(e). Withdrawal of this objection is respectfully requested.

II. Rejection of Claims 1-7, 22, 23, 26, 28-32 Under 35 U.S.C. §102(b)

Claims 1-7, 22, 23, 26, 28-32 stand rejected under 35 U.S.C. §102(b) as being anticipated by Gupta *et al.* (US Patent 5,361,871.)

Withdrawal of this rejection is respectfully requested for at least the following reasons. Gupta *et al.* does not teach or suggest the claimed invention.

For a prior art reference to anticipate, 35 U.S.C. §102 requires that "each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (quoting *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2USPQ2d 1051, 1053 (Fed. Cir. 1987)).

The subject invention as claimed relates to an interactive shopping/marketing system that employs a wireless data collecting device, a comprehensive data base, and a *host computer in communication with the data collecting device via* and an intermediate device; *e.g.* to the extent received data by the host computer requires a response, the host computer retrieves data from the comprehensive data base, processes information and

09/990,597

467XXBX

retransmits data to the portable terminals employed by the user. In addition, the central host can communicate with third party servers, *e.g.* merchants. Such aspects of the claimed invention are not taught or suggested by Gupta *et al.* – Rather, Gupta *et al.* discloses a product information system, wherein product information are stored in the memory of bar code scanners, and at the cashier's counter the products to be purchased are re-scanned and compared to the initial scan of the user. The units are then retrieved and updated with new pricing information. No communication of a host computer with data collection devices as in applicants' claimed invention is taught or suggested by Gupta *et al.*

Independent claim 1 recites: “*a central host [...] in communication with the data collecting device via an intermediate consumer presentation device*”. Similarly, independent claim 22 recites “*a host computer having a communication link for receiving the product identification number registered by the first product*”. It is readily apparent that such aspects of the claimed invention are not taught or suggested by Gupta *et al.*

In view of the at least above comments it is respectfully submitted that Gupta *et al.* does not teach or suggest the subject invention as recited in independent claim 1, independent claim 22, claims 2-7, and claims 23, 26, 28-32 that respectively depend therefrom, and this rejection should be withdrawn.

III. Rejection of Claims 8-21, 24, 25, 27, 52-56, and 75-79 Under 35 U.S.C. §103(a)

Claims 8-21, 24, 25, 27, 52-56, and 75-79 stand rejected under 35 U.S.C. §103(a) as being obvious over Gupta *et al.* Withdrawal of this rejection is respectfully requested for at least the following reasons.

Claims 8, 9 depend from claim 1, and as explained *supra* Gupta *et al.* does not teach or suggest the subject independent claim. Independent claim 10 and claims 11-21 dependent therefrom recite a similar limitation of “*a host computer having a communication link for receiving [...] registered by the wireless shopping device*”, and as explained *supra*, such features are not taught or suggested by Gupta *et al.* Also, claims 24, 25, 27 depend from independent claim 22, and as explained *supra* Gupta *et al.*

09/990,597

467XXBX

does not teach or suggest this independent claim. In addition, independent claim 52 and claims 53-56 dependent therefrom recite the limitation of "*the host computer* having a communication link [...] for *communicating with the shopping device*", and as explained *supra*, such features are not taught or suggested by Gupta *et al.* Independent claim 75 and claims 76-79 dependent therefrom recite the limitation of "*via scanning with a wireless data collection device in communication with a central host*", and as explained *supra* such features are not taught or suggested by Gupta *et al.*

Moreover, the rationale proffered by the Examiner to modify Gupta *et al.* is to achieve benefits identified in applicants' specification, which overcome problems associated with conventional systems/methods. Applicants' representative respectfully submits that this is an unacceptable and improper basis for a rejection under 35 U.S.C. §103. In essence, the Examiner is basing the rejection on the assertion that it would have been obvious to do something not suggested in the art because so doing would provide advantages stated in applicants' specification. Such rationale has been condemned by the CAFC. *See, for example, Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987). It is noted that even if Gupta *et al.* is modified, applicants' claimed invention still does not result.

In view of the at least above comments it is respectfully submitted that Gupta *et al.* does not teach or suggest the subject invention as recited in claims 8-21, 24, 25, 27, 52-56, 75-79, and this rejection should be withdrawn.

09/990,597

467XXBX

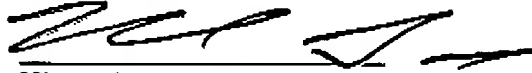
CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,
AMIN & TUROCY, LLP


Himanshu S. Amin
Reg. No. 40,894

AMIN & TUROCY, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731